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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,036	03/25/2002	Roger S Alberto	1373 WO/US	9483
24289	7590	03/30/2005	EXAMINER	
Mallinckrodt Inc. 675 McDonnell Boulevard PO Box 5840 St. Louis, MO 63134			ZUCKER, PAUL A	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,036

Applicant(s)

ALBERTO ET AL.

Examiner

Paul A. Zucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12, 16-19 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-19 is/are allowed.
- 6) ☒ Claim(s) 10-12 and 25-41 is/are rejected.
- 7) ☐ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/5/2004, 1/13/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election, without traverse, of Group II, claims 10-12 and 16-20, in the reply filed on 28 January 200 is acknowledged.

Specification

2. The disclosure is objected to because of the following informalities: Page 4, line 18:
The date of the reference to *Berg et al* should be changed from 1936 to 1937.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-12 and 25-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10 and 34 recite the limitation "using a compound of the following formula as a CO source and as a reducing agent" in line 3 of each claim. Since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Claims 10 and 34 and their dependents are therefore rendered indefinite.

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4. Claims 10-12 and 25-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the variables R and R_y in lines 8 and 10. R and R_y , however, have not been defined. It is therefore impossible to determine the metes and bounds of Applicants claimed invention. Claim 10 and its dependents are therefore rendered indefinite.

Allowable Subject Matter

5. Claim 16 is drawn to allowable subject matter. Claims 17-19 are allowed. The following is a statement of reasons for the indication of allowable subject matter: The instantly claimed process for the preparation of boranocarbonate is neither disclosed nor fairly suggested by the closest prior art Mayer a (Monatshefte fur Chemie, 1971, 102, pages 940-945) and Malone et al Inorganic Chemistry, 1967, 644, pages 17-822). Mayer exemplifies (Page 943, Table I, entry h) the reaction of borane in THF solution with carbon monoxide gas to give the adduct H_3BCO . Malone teaches (Page 821, column 1 from heading "Experimental Section" through end of paragraph bridging columns 1 and 2) the reaction of H_3BCO in alcoholic KOH to give the solid boranocarbonate salt. Together these teachings combined produce the instantly claimed process. One of ordinary skill in the art, however, would not have been motivated to select THF as the solvent for reaction of BH_3 and CO to produce H_3BCO since although Mayer exemplifies the reaction, it proceeds in only 4% yield with the competitive formation of THF-boron adducts predominating (See Mayer, abstract). Thus Mayer teaches away from the use of THF solvent in the

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production of H_3BCO . The instantly claimed process is therefore patentable over the teachings of Mayer and Malone.

Claim Objections

6. Claim 16 is objected to because of the following informalities: Applicants should remove the space between the words "borano" and "carbonate" on line 1.

Appropriate correction is required.

7. Claim 16 is objected to because of the following informalities: Applicants should change the word "kation" and "cation" on line 6. Appropriate correction is required.

Conclusion


8. Claims 10-12, 16 -19 and 25-41 are pending. Claims 10-12 and 25-41 are rejected. Claim 16 is objected to. Claims 17-19 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAULA A. ZUCKER, PH.D.
PRIMARY EXAMINER